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**FROM:** Mark R. Woodall  
KRAMER & AMADO, P.C.

**DATE:** February 26, 2008

**SUBJECT:** U.S. Patent Application  
Title: TRACING ACTIVE CONNECTION MODIFY FAILURES  
Serial No.: 10/724,711  
Attorney Docket No.: ALC 3101

**PAGES:** INCLUDING COVER PAGE (15)

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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/724,711	
	Filing Date	December 2, 2003	
	First Named Inventor	Mark Woodall	
	Art Unit	2143	
	Examiner Name	Danielle C. Murray	
Total Number of Pages in This Submission	<b>14</b>	Attorney Docket Number	ALC 3101

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks  		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Kramer & Amado, P.C.		
Signature			
Printed name	Mark R. Woodall		
Date	February 26, 2008	Reg. No.	43,286

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:			
Signature			
Typed or printed name	Mark R. Woodall	Date	February 26, 2008

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/17 (10-07)

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**FEE TRANSMITTAL**  
**For FY 2008**☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 510.00

**Complete if Known**

Application Number	10/724,711
Filing Date	December 2, 2003
First Named Inventor	Mark Weedmark
Examiner Name	Daniele C. Murray
Art Unit	2143
Attorney Docket No.	ALC 3101

**METHOD OF PAYMENT (check all that apply)**☐ Check ☒ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_☒ Deposit Account Deposit Account Number: 500578 Deposit Account Name: Terry W. Kramer

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

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☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

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**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	310	155	510	255	210	105	
Design	210	105	100	50	130	65	
Plant	210	105	310	155	160	80	
Reissue	310	155	510	255	620	310	
Provisional	210	105	0	0	0	0	

**2. EXCESS CLAIM FEES**

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	210	105
Multiple dependent claims	370	185

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
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- 20 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
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- 3 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of independent claims paid for, if greater than 3.

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$260 (\$130 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
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- 100 = \_\_\_\_\_ / 50 = \_\_\_\_\_ (round up to a whole number) x \_\_\_\_\_ = \_\_\_\_\_

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Appeal Brief Fee

Fees Paid (\$)

\$510.00

**SUBMITTED BY:**

Signature	<i>Mark R. Woodall</i>	Registration No. (Attorney/Agent) 43,286	Telephone 703-519-9801
Name (Print/Type)	Mark R. Woodall	Date February 26, 2008	

This collection of information is required by 37 CFR 1.138. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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FEB 26 2008

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of : Mark Weedmark, et al.  
For : TRACING ACTIVE CONNECTION MODIFY  
Serial No.: : 10/724,711  
Filed : December 2, 2003  
Art Unit : 2143  
Examiner : Daniele C. Murray  
Att. Docket : ALC 3101  
Confirmation No. : 2221

**APPEAL BRIEF**

Mail Stop Appeal Brief Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed December 26, 2007.

**I. REAL PARTY IN INTEREST**

The real party in interest is ALCATEL, way of an Assignment recorded at Reel 014757, frame 0014.

02/28/2008 SSANDARA 00000019 10724711

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510.00 OP

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Attorney's Docket No: ALC 3101

## **II. RELATED APPEALS AND INTERFERENCES**

Following are identified any prior or pending appeals, interferences or judicial proceedings, known to Appellant, Appellant's representative, or the Assignee, that may be related to, or which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal:

NONE.

## **III. STATUS OF CLAIMS**

Claims 1-8 are on appeal.

Claims 1-8 are pending.

No claims are allowed.

Claims 1-8 are rejected.

No claims are canceled.

## **IV. STATUS OF AMENDMENTS**

All Amendments have been entered.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The subject matter recited in claim 1 relates to a method for of an active connection modify in a connection oriented communication network (see, e.g., [0001], [0009], [0019]), comprising the steps of: appending a trace transit list information element (TTL IE) to a modify

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request message (see, e.g., [0010], [0019], [0022]-[0027]; Figs. 1, 2A, 2B, 3); transmitting said modify request message from a source node to a destination node along said active connection (see, e.g., [0010], [0022] -[0027]; Figs. 1, 2A, 2B, 3); and at each node along said active connection, modifying a parameter of said active connection while recording in said TTL IE failure identification data (see, e.g., [0010]-[0011], [0022] -[0027]; Figs. 1, 2A, 2B, 3).

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The following grounds of rejection are presented for review:

A. Claims 1-8 are rejected under 35 U.S.C. § 102(e) as allegedly being allegedly anticipated by U.S. Patent No. 6,643,267 to Karia et al. (hereinafter "Karia").

## **VII. ARGUMENT**

### **A. Rejection of Claims 1-8 Under 35 U.S.C. §102(e)**

The Final Office Action dated August 23, 2007, rejects claims 1-8 under 35 U.S.C. § 102(e) as being allegedly anticipated by Karia.

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 U.S.P.Q. 481, 485 (Fed. Cir.

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1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Put similarly, the test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

*Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131. The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

As a preliminary matter regarding claim 8, although the caption of the rejection on page 2 of the Final Office Action indicates that the rejection is only a rejection of claims 1-7, Appellant notes that, on page 4, the rejection includes a discussion of claim 8. Further, Appellant notes that the Office Action Summary indicates that claim 8 is rejected. Thus, Appellant believes that the caption indicating that the rejection is a rejection of claims 1-7 is a vestige from the rejection that appeared in the December 27, 2006, non-final Office Action, inadvertently copied into the pending rejection.

Excessive and Improper Reliance on "Inherency"

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The rejection relies on an inherency argument three times in connection with claim 1. The rejection further relies on additional inherency arguments twice with respect to dependent claim 2. The Office Action further relies on an inherency argument with respect to dependent claim 3. The Office Action further relies on an inherency argument with respect to dependent claim 4. The Office Action further relies on an inherency argument with respect to dependent claim 6. The Office Action further relies on an inherency argument with respect to dependent claim 7. The Office Action further relies on two additional inherency arguments with respect to dependent claim 8. In all, the Office Action relies on eleven inherency arguments with respect to the rejection of pending claims 1-8.

Appellant notes that the rejection of claims 1-7 is repeated verbatim from the rejection of those claims that appeared in the December 27, 2006, non-final Office Action. In response thereto, Appellant pointed out that the rejection correctly concedes that Karia fails to disclose, teach or suggest a large portion of the subject matter recited in the rejected claims. In fact, Appellant respectfully asserts that the rejection correctly concedes that Karia fails to disclose, teach or suggest significantly more than half of the subject matter recited in the rejected claims! On this basis alone, Appellant respectfully asserts that the Office Action has excessively and improperly relied on allegations of inherency in putting forth the rejection. Appellant respectfully asserts that the rejection should be reversed on this basis alone.

In support of the foregoing position, by way of example, and by way of example only, Appellant's May 17, 2007, Amendment focused on the recitation in claim 1 of "modifying a parameter." In particular, the December 27, 2006, Office Action correctly concedes that much of the subject matter recited in claim 1 is not disclosed by Karia. However, the December 27, 2006, Office



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Action, like the outstanding Final Office Action, repeatedly asserts that subject matter recited in claim 1 is inherent in Karia.

Claim 1 recites three steps in a method. One of the three steps recited in claim 1 is the step of "modifying a parameter." The Office Action relies entirely on an inherency argument with respect to this step in the recited method.

Appellant respectfully submits that the step of modifying a parameter, according to the combination recited in claim 1, is not inherently disclosed by Karia. In fact, it is respectfully submitted that this deficiency in the rejection is evident even by the Office Action's own assertion regarding what is allegedly inherent. Specifically, "the use of ATM networks which by definition incorporate the reservation of resources in conjunction with a Modify Request message" in no way describes "modifying a parameter" as recited in claim 1.

In sections 4 and 5 on pages 5 and 6, the Final Office Action includes a Response to Arguments section. However, the Response to Arguments section entirely ignores Appellant's argument that the reliance on inherency in the rejection is excessive and improper.

#### Improper Reliance On Secondary References

In the Response to Arguments section, both in section 4 on page 5 and extensively in section 5 on page 6, the Response to Arguments relies on documents made of record by Appellant. Appellant respectfully submits that the rejection's reliance on these many documents in connection with the rejection, without applying the documents as documents relied upon as the basis for the rejection, is improper.

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Appellant respectfully submits that, in order to be properly crafted, the rejection should be listed as a rejection(s) under 35 U.S.C. §103(a) based on combinations of Karia and the additional documents relied upon in the Response to Arguments sections 4 and 5 on pages 5 and 6. Appellant respectfully submits that, even assuming *arguendo* that the Office Action's reliance on the many documents is proper, which it is not, at a minimum the rejection is reversible due to its failure to apply all the documents relied upon for the rejection.

Appellant respectfully requests that the rejection be reversed on this basis as well.

For at least the foregoing reasons, claims 1-8 are patentable over Karia because Karia does not disclose each and every element recited in claims 1-8.

#### CONCLUSION

For at least the reasons discussed above, it is respectfully submitted that the rejections are in error and that claims 1-8 are in condition for allowance. For at least the above reasons, Appellants respectfully request that this Honorable Board reverse the rejections of claims 1-8.

Respectfully submitted,

KRAMER & AMADO, P.C.

February 26, 2008

Date

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Mark R. Woodall  
Reg. No. 43,286

Application No: 10/724,711  
Attorney's Docket No: ALC 3101

### VIII. CLAIMS APPENDIX

#### CLAIMS INVOLVED IN THE APPEAL:

1. A method for of an active connection modify in a connection oriented communication network, comprising the steps of:

appending a trace transit list information element (TTL IE) to a modify request message;

transmitting said modify request message from a source node to a destination node along said active connection; and

at each node along said active connection, modifying a parameter of said active connection while recording in said TTL IE failure identification data.

2. The method of claim 1, further comprising:

generating a Modify Reject message at a node along said connection if said node does not enable modification of said parameter;

updating said TTL IE from said modify request message with failure cause information;

and

appending said TTL IE to said Modify Reject message and returning said Modify Reject message to said source node.

3. The method of claim 1, wherein said failure identification data includes the logical node and logical port trace of the failed modify request.

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4. The method of claim 1, wherein said failure identification data includes failure cause information.
5. The method of claim 4, wherein said failure cause information includes vendor specific information.
6. The method of claim 1, wherein said parameter is the bandwidth allocated to said active connection.
7. The method of claim 1, wherein said failure identification data includes the capability of a node along said active connection to support the modification of an active connection of said parameter.
8. The method of claim 1, further comprising:
  - generating a Modify Acknowledgement message at said destination node if all nodes along said connection enable modification of said parameter;
  - transmitting said Modify Acknowledgement message to said source node; and
  - transmitting traffic from said source node to said destination node along said connection with said modified parameter.

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#### **IX. EVIDENCE APPENDIX**

A copy of the following evidence 1) entered by the Examiner, including a statement setting forth where in the record the evidence was entered by the Examiner, 2) relied upon by the Appellant in the appeal, and/or 3) relied upon by the Examiner as to the grounds of rejection to be reviewed on appeal, is attached:

NONE.

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Attorney's Docket No: ALC 3101

#### **X. RELATED PROCEEDINGS APPENDIX**

Copies of relevant decisions in prior or pending appeals, interferences or judicial proceedings, known to Appellant, Appellant's representative, or the Assignee, that may be related to, or which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal are attached:

NONE.